

## REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1-18 and 20-49 are currently pending in the application, with Claims 1 and 38 being the independent claims.

Claims 1 and 38 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claim 1 of U.S. Patent No. 6,676,254 B2, the parent of the present divisional application. Applicants expect to file a terminal disclaimer with respect to this patent after receiving an indication of otherwise allowable subject matter, and respectfully request that this rejection be held in abeyance.

Claims 1-17, 20-28 and 33-35 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Teraoka et al. (U.S. Patent No. 5,865,883) in view of Iwata et al. (U.S. Patent No. 5,101,217) and Auslander et al. (U.S. Patent No. 5,681,381).

Claim 18 was rejected under 35 U.S.C. § 103(a) as allegedly obvious over the same three references and further in view of Takemoto et al. (U.S. Patent No. 6,084,619).

Claims 29-32 and 36-37 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over the same three references and further in view of Likavec et al. (U.S. Patent No. 6,169,185) and Sakaki et al. (U.S. Patent No. 5,570,120).

Claims 38-49 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Teraoka et al. in view of Iwata et al.

Applicants respectfully request reconsideration of these rejections.

Before addressing the merits of the rejections, Applicants believe it will be helpful to review some features and advantages of the present invention. The present invention, as recited in Claim 1, relates to a recording method comprising a step of providing an ink from a recording head to a recording medium through a gap provided between the recording head and

the recording medium. The ink is supplied to the recording head from an ink tank comprising an ink contact member. The ink contacts the ink contact member. The ink comprises:

- (i) a fluorescent coloring material;
- (ii) a nonionic surfactant;
- (iii) a compound which is not compatible with (ii); and
- (iv) a liquid medium for dissolving or dispersing (i), (ii) and (iii).

The ink contact member comprises at least one compound selected from the group consisting of polyacetate and polyolefin. Independent Claim 38 relates to an ink cartridge comprising an aqueous ink of comparable scope, and an ink contact member.

The recording method of the present invention achieves long-lasting, strong fluorescent intensity and coloring of the recorded image. The mechanism of this phenomenon is explained in detail in the specification at page 12, line 11 to page 14, line 21 and in Figs. 7-12. As explained in the specification, it is the combined use of the claimed components that provides the unexpected beneficial effects. Furthermore, the use of an ink-contacting member that is made of the recited material enables stable and long-term expression of the above-noted beneficial effects.

In Applicants' view, the cited references do not teach or suggest the claimed invention.

Teraoka et al. teaches the use of fluorescent dyes, nonionic surfactant and other organic compounds in an ink. As the Examiner acknowledges, Teraoka et al. does not teach or suggest the combination of using a nonionic surfactant and a compound having no compatibility with the nonionic surfactant.

Iwata et al. discloses the use of polyhydric alcohols, such as a sugar alcohol or glycerin in an ink. These compounds are, however, recited as viscosity-adjusting materials, along with a list of other possible compounds that may be used, or they are used merely as a solvent. Of course, Iwata et al. does not teach compatibility or non-compatibility of these

compounds with a nonionic surfactant — it is Teraoka et al. that uses a non-ionic surfactant. Moreover, Iwata et al. states that any coloring material can be used (see col. 4, lines 16-25). It does not specifically teach or suggest the use of fluorescent coloring materials.

Auslander et al. teaches the use of a fluorescent coloring material and a nonionic surfactant having an HLB of 8-13 in an ink. Applicants note, however, that the HLB value of the nonionic surfactant is not a recited element in independent claims 1 and 38 of the present application.


The combination of these three references is not seen to teach or suggest the features of the present invention that a nonionic surfactant and a compound that is not compatible with the nonionic surfactant should be used together, in a fluorescent ink. Picking and choosing selected components from various ink formulations does not render the claimed invention obvious.

Regarding the other references, Takemoto et al. was cited for its teaching of structural formula I, Likavec et al. was cited for its teachings regarding non-fluorescent (azo) dye and pH, and Sakaki et al. was cited for its teachings regarding surface tension. Applicants submit that these references do not remedy the deficiencies of the Teraoka et al./Iwata et al./Auslander et al. combination.

Applicants conclude that the cited references, whether taken singly or in the combinations proposed by the Examiner (assuming that such combination is proper) do not teach or suggest the features of the present invention as recited in independent Claims 1 and 38. Applicants submit that the present invention is patentably defined by independent Claims 1 and 38. The dependent claims are allowable for the same reasons as their respective independent claims, as well as for the patentable features recited therein. Individual consideration of the dependent claims, and withdrawal of the Section 103 rejections are respectfully solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

  
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